



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

CERTIFICATE UNDER 37 C.F.R. §1.10

I hereby certify that the documents enclosed herein are being deposited with the United States Postal Service on this 12 day of March, 2004 with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

Michelle Ludwig
Michelle Ludwig

In re application of:

Dan et al.

Serial No.: 10/064,001

Filed: June 3, 2002

For: Novel Method for the Production of Transgenic
Plants

)

)

) Examiner: Unknown

)

) Group Art Unit: 1638

)

) Conf. No. 7199

)

)

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

TRANSMITTAL LETTER

Transmitted herewith are the following documents in the above-identified application.

- X Certification for Information Disclosure Statement (37 CFR 1.97(e))
- X PTO Form 1449
- X Ten (10) References
- X If an extension or an additional extension of time is required, but is not enclosed, please consider this a conditional petition therefor and charge Deposit Account 13-4125 accordingly.
- X No fee is believed required with this filing.
- X Please charge any deficiencies or credit any overpayment to Deposit Account 13-4125. A duplicate copy of this sheet is attached.

Respectfully submitted,

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Attorney's Docket No. 38-21(15648)C

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Dan et al.

Group No. 1638

Serial No.: 010 064,001

Examiner: Unknown

Filed: June 3, 2002

For: Novel Method for the Production of Transgenic Plants

Assistant Commissioner for Patents

Washington, D.C. 20231

**CERTIFICATION FOR INFORMATION DISCLOSURE STATEMENT
(37 CFR 1.97(e))**

NOTE: A certification must state either: "(1) that each item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the statement, or (2) that no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application or, to the knowledge of the person signing the certificate after making reasonable inquiry, was known to any individual designated in § 1.56(c) more than three months prior to the filing of the statement." 37 CFR 1.97(e).

NOTE: "Section 1.97(e) makes it clear that a certification could contain either of two statements. One statement is that each item of information in an information disclosure statement was cited in a search report from a patent office outside the U.S. not more than three months prior to the filing date of the statement. Under this certification, it would not matter whether any individual with a duty actually knew about any of the information cited before receiving the search report. In the alternative, the certification could state that no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application or, to the knowledge of the person signing the certification after making reasonable inquiry, was known to any individual having a duty to disclose more than three months prior to the filing of the statement." Notice of January 9, 1992, 1135 O.G. 13-25, at 13. (emphasis added). Thus: "If an item of information is submitted within three months of being cited in a communication from a foreign patent office in a counterpart foreign application, the certification can be properly made regardless of any individual's previous knowledge of the information." *Id.*, 1135 O.G. at 19.

NOTE: "The certification can be based on present, good faith knowledge about when information became known without a search of files being made." Thus, for example, the certification of § 1.97(e) does not preclude the use of the certification in an application by corporations whose practitioners have over the years reviewed thousands of patents and technical publications, even though they are unaware of the relevance of any one thereof to the application. Notice of January 9, 1992, 1135 O.G. 13-15, at 19.

CERTIFICATE OF MAILING/TRANSMISSION (37 CFR 1.8a)

I hereby certify that this correspondence is, on the date shown below, being:

MAILING

☒ deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to the

Assistant Commissioner for Patents, P.O. Box 1450

Washington, D.C. 20231 Alexandria, VA 22313-1450

Date: 3/12/2004

FACSIMILE

☐ transmitted by facsimile to the Patent and Trademark Office.

Signature

Michelle Ludwig

(type or print name of person certifying)

NOTE: A copy of the foreign search report need not be submitted with the certification. Notice of April 20, 1992 (1138 O.G. 37-41, 40).

NOTE: "The phrase 'after making reasonable inquiry' makes it clear that the individual making the certification has a duty to make reasonable inquiry regarding the facts that are being certified. The certification can be made by a registered practitioner who represents a foreign client and who relies on statements made by the foreign client as to the date the information first became known. A registered practitioner who receives information from a client without being informed whether the information was known for more than three months, however, cannot make the certification without making reasonable inquiry. For example, if an inventor gave a publication to the attorney prosecuting an application with the intent that it be cited to the Office, the attorney should inquire as to when that inventor became aware of the publication and should not submit a certification under 37 CFR 1.97(e)(2) to the Office until a satisfactory response is received. The certification can be based on present, good faith knowledge about when information became known without a search of files being made." Notice of April 20, 1992 (1138 O.G. 37-41, 39).

NOTE: "Although it is recognized that an individual actually becomes aware of the information in the communication from a foreign patent office sometime after it was mailed, the mailing date of such a communication, if it occurs prior to a first awareness of the same information, would determine the date for filing of an information disclosure statement without a fee" in a certification procedure under § 1.97(e). Notice of January 9, 1992, 1135 O.G. 13-25, at 19 (emphasis added).

NOTE: "The certification under § 1.97(e) should be made by a person who has knowledge of the facts being certified. The certification can be made by a practitioner who represents a foreign client and who relies on statements made by the foreign client as to the date the information first became known. A practitioner who receives information from a client without being informed whether the information was known for more than three months, however, cannot make the certification without making reasonable inquiry." Notice of January 9, 1992, 1135 O.G. 13-25 at 19.

NOTE: "The term counterpart foreign patent application means that a claim for priority has been made in either the U.S. application or a foreign application based on the other, or that the disclosures of the U.S. and foreign patent applications are substantively identical (e.g., an application filed in the European Patent Office claiming the same U.K. priority as claimed in the U.S. application)." Notice of April 20, 1992 (1138 O.G. 37-41, 39).

NOTE: "Individuals other than the attorney, agent or inventor may comply with this section by disclosing information to the attorney, agent or inventor." 37 CFR 1.56(d) and
"Individuals associated with the filing or prosecution of a patent application within the meaning of this section are:

- (1) each inventor named in the application;
- (2) each attorney or agent who prepares or prosecutes the application; and
- (3) every other person who is substantively involved in the preparation or prosecution of the application and who is associated with the inventor, with the assignee or with anyone to whom there is an obligation to assign the application." 37 CFR 1.56(c).

IDENTIFICATION OF INFORMATION DISCLOSURE STATEMENT FOR WHICH THIS CERTIFICATION IS BEING MADE

1. This certification is being made for the Information Disclosure Statement

☒ accompanying this certification.

☐ filed _____
date

CERTIFICATION

2. I, the person(s) signing below certify

(check appropriate item)

- ☒ that each item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the statement. 37 CFR 1.97(e)(1).

NOTE: The three month period starts from the mailing date of the foreign patent office communication. Notice of January 9, 1992, 1135 O.G. 13-25 at 19. The mailing date is the "date on the communication by the foreign patent office." Notice of April 20, 1992 (1138 O.G. 37-41, 39).

OR

- ☐ that no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application or to the knowledge of the person signing the certification after making reasonable inquiry, was known to any individual designated in § 1.56(c) more than three months prior to the filing of the statement. 37 CFR 1.97(e)(2).

NOTE: "The time at which information 'was known to any individual designated in 37 CFR 1.56(c)' is the time when the information was discovered in association with the application even if awareness of the materiality came later." Notice of April 20, 1992 (1138 O.G. 37-41, 40).

IDENTIFICATION OF PERSON(S) MAKING THIS CERTIFICATION

3. The person making this certification is

(check each applicable item)

- (a) ☐ the inventor(s) who signs below

SIGNATURE OF INVENTOR

(type name of inventor who is signing)

- (b) ☐ a person who is substantively involved in the preparation or prosecution of the application, and who is associated with the inventor, with the assignee, or with anyone to whom there is an obligation to assign the application (37 CFR 1.56(c)) and who signs below.

SIGNATURE OF PERSON

type name of person who is signing

Address of person who is signing

(c) ☒ the attorney who signs below on the basis of the information:

(check each applicable item)

- ☐ supplied by the inventor(s).
- ☐ supplied by an individual designated in § 1.56(c).
- ☒ in the attorney's file.

NOTE: "Certification need not be in the form of an oath or a declaration under 37 CFR 1.68. Certification by a registered practitioner or any other individual that the statement was filed within the three-month period of either first citation by a foreign patent office or first discovery of the information will be accepted as dispositive of compliance with this provision in the absence of evidence to the contrary." . . . "A statement on information and belief would not be sufficient." Notice of April 20, 1992 (1138 O.G. 37-41, 39-40).



SIGNATURE OF ATTORNEY

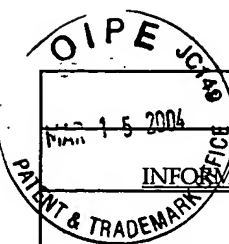
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				ATTY. DOCKET NO. 38-21(15648)C		APPLICATION NO. 10/064,001	
FORM PTO-1449 INFORMATION DISCLOSURE STATEMENT				APPLICANT Dan et al.			
FILING DATE June 3, 2002				GROUP 1638			
U.S. PATENT DOCUMENTS							
EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUB- CLASS	FILING DATE
	AA	5,932,782	8/3/1999	Bidney			
	AB	5,969,213	10/19/1999	Adams et al.			
FOREIGN PATENT DOCUMENTS							
EXAMINER INITIAL		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUB- CLASS	TRANSLATION
	AC	WO 95/06127	3/2/1995	PCT			Yes No
	AD	WO 96/04392	2/15/1996	PCT			Yes No
	AE	WO 98/51806	11/19/1998	PCT			Yes No
OTHER (Including Author, Title, Date, Pertinent Pages, etc.)							
	AF		Francis et al., The plant cell cycle, <i>Physiologia Plantarum</i> 93:365-374 (1995)				
	AG		Leduc et al., Gene transfer to inflorescence and flower meristems using ballistic micro-targeting, <i>Sexual Plant Reproduction</i> 7:135-143 (1994)				
	AH		Sautter et al., Ballistic Microtargeting of Visible Marker Genes to the Shoot Meristem of Wheat, In <i>Potrykus and Spangenberg (eds)</i> , pgs 152-156 (1994)				
	AI		Sautter et al., Shoot apical meristems as a target for gene transfer by micro ballistics, <i>Euphyticac</i> 85:45-51 (1995)				
	AJ		Terada et al., A type I element composed of the hexamer (ACGTCA) and octamer (CGCGGATC) motifs plays a role(s) in meristematic expression of a wheat histone H3 gene in transgenic rice plants, <i>Plant Molecular Biology</i> 27:17-26 (1995)				
EXAMINER					DATE CONSIDERED		
EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to Applicant.							